Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated December 30, 2003, indicated that: claims 2-4, 9, 15, 16 and 24 are objected to and would be allowable if rewritten; and that many of the claims stand rejected as follows: (1) claims 1, 10, 20-22 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 21-22 and 26 of U.S. Patent No. 6,488,405 in view of Nikawa ('956); (2) it appears that claims 5-6, 11-13, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable and provisionally rejected under the judicially created doctrine of obviousness-type double patenting as applied to claims 1, 10, 17, 20-22 of U.S. Patent No. 6,488,405 above, and further in view of Nikawa ('956); (3) it appears that claims 7-8, 14, 17 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable and provisionally rejected under the judicially created doctrine of obviousness-type double patenting as applied to claims 1, 10, 17, 20-22 of U.S. Patent No. 6,488,405 in view of Nikawa ('956) above, and further in view of Channin ('199); and (4) claim 19 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,488,405 in view of Nikawa ('956) above, and further in view of Kantor et al ('408).

Applicant appreciates the indication of allowability for claims 2-4, 9, 15-16, and 24, were Applicant to rewrite them in independent form including all of the limitations of the base claim and any intervening claims. In view of the following, however, Applicant would prefer to assess this opportunity at a later date.

(1) With regards to the rejection of claims 1, 10, 20-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 21-22 and 26 of U.S. Patent No. 6,488,405 in view of the '956 reference, Applicant respectfully traverses. This rejection is based on flawed rationale for combining the teachings. Accordingly, Applicant requests that this rejection be removed.

The Office Action alleges that the skilled artisan would use the heat source of the '956 reference as a replacement for the polarized-laser teaching of the '405 reference because of reasons taught by the '956 reference and concerning the ability to observe surface defects inside the LOC chip packaged device. This cited discussion in the '956 reference pertains to the test device being in a package (that encloses the die); because the die is enclosed in the package, one cannot observe surface defects of the die inside the package. For this reason, the '956 reference teaches testing by "circuit monitoring" in which case the die is tested. The claimed subject matter of the '405 reference concerns a thinned die where surface defects are directly observable. Thus, there would be no reason or other motivation to implement such a change as suggested in the Office Action. Accordingly, Applicant requests that this rejection be removed.

(2) With regards to the rejection of claims 5-6, 11-13, and 18, Applicant assumes that the rejection is based on 35 U.S.C. 103(a) and that the reference to the judicially created doctrine of obviousness-type double patenting was not intended. With this assumption, Applicant traverses this rejection for the same reasons discussed above. Moreover, with respect to these particular combinations of teachings, to the extent that the Office Action would be implicitly suggesting that there is other motivation for the combination of these specific teachings, no motivation is expressly stated and therefore none is evidenced. These claims are dependent on claim 1 and further elaboration should not be needed. Accordingly, Applicant requests that this rejection be removed.

(3) With regards to the rejection of claims 7-8, 14, 17 and 23, Applicant again assumes that the rejection is based on 35 U.S.C. 103(a) and that the reference to the judicially created doctrine of obviousness-type double patenting was not intended. With this assumption, Applicant traverses this rejection for the same reasons discussed above in connection with the rejection of claims 1, 10, 20-22 under the judicially created doctrine of obviousness-type double patenting. Motivation for the basic combination of teachings is lacking. These claims are also dependent on claim 1 and further elaboration should not be needed. Accordingly, Applicant requests that this rejection be removed.

(4) With regards to the rejection of claim 19 as being provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of the '405 reference in view of the Nikawa '956 reference above (the first combination), and further in view of the Kantor '408 reference (the second combination), Applicant also respectfully traverses this rejection for reasons similar to those discussed above in connection with the rejection of claims 1, 10, 20-22 under the judicially created doctrine of obviousness-type double patenting. Motivation for the basic combination of the teachings of these three references is lacking. With regards to the first combination, these teaching are not motivated for the reasons explained previously herein. With regards to the second combination, according to the Office Action, the motivation is apparent from the last line of the '405 abstract. This abstract, however, expressly explains that the '408 die is operating during testing of the die and that pulsing is advantageous to avoid current spikes associated with clock edges. Applicant fails to recognize where the '405 reference teaches a concern with spikes at clock edges. For this and other reasons, Applicant submits that there is no evidence that would motivate the skilled artisan to implement the proposed combination of teachings. Accordingly, Applicant requests that this rejection be removed.

Alternatively, Applicant invokes 35 U.S.C. § 103(c) to negate the applicability of each of these obviousness (-type) rejections that rely upon the '405 reference. To the extent that claims of the '405 reference are directed to subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e), that is now disqualified as prior art against Applicant's claimed invention. This conclusion follows because Applicant's claimed invention and this subject matter of the '405 reference were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person as evidenced by the face of the '405 reference and the assignment recorded at Reel/Frame 012046/0664; showing that the assignee is common.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any

remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

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By: _____
Robert J. Crawford
Reg. No. 32,122